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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,646	10/09/2001	Tetsuo Nishikawa	Nanjo C-1	6210

7590 06/14/2004
FLYNN, THIEL, BOUTELL & TANIS, P.C.
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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,646

Applicant(s)

NISHIKAWA ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,12 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,12 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. In light of the new grounds of rejection as set forth below, the following action is non-final and thus, the finality of the previous office action has been withdrawn.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawamura et al. (U.S. 5,908,874).

Kawamura et al. disclose composition comprising 80-99% tungsten powder and remainder styrene rubber. There is also disclosed molded article made from this composition. Attention is drawn to example 4 which discloses composition comprising 92% tungsten and 8% styrene thermoplastic elastomer, i.e. styrene butadiene rubber (col.3, lines 37-39 and 44-48, col.4, line 53-col.5, line 2, col.5, line 65, and example 4).

Although there is no explicit disclosure regarding the surface hardness or specific gravity of the molded article, given that Kawamura et al. disclose molded article comprising identical type and amount of ingredients, it is clear that the molded article would inherently possess surface hardness and specific gravity as presently claimed.

In light of the above, it is clear that Kawamura et al. anticipate the present claims.

4. Claims 1, 3-7, 12, and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakaki et al. (U.S. 6,364,422).

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The rejection is adequately set forth in paragraph 4 of the office action mailed 6/11/03 and is incorporated here by reference.

5. Claims 1, 4-7, and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Gallucci et al. (U.S. 6,300,399).

The rejection is adequately set forth in paragraph 4 of the office action mailed 12/23/03 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallucci et al. (U.S. 6,300,399) in view of Sakaki et al. (U.S. 6,364,422).

The rejection is adequately set forth in paragraph 4 of the office action mailed 6/11/03 and is incorporated here by reference.

8. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaki et al. (U.S. 6,364,422) in view of Gallucci et al. (U.S. 6,300,399).

The rejection is adequately set forth in paragraph 7 of the office action mailed 12/23/03 and is incorporated here by reference.

37 CFR 1.131 Affidavit

9. The affidavit filed on 5/27/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Sakaki et al. (U.S. 6,364,422) and Gallucci et al. (U.S. 6,300,399) references.

10. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Sakaki et al. or Gallucci et al. reference to either a constructive reduction to practice or an actual reduction to practice.

Specifically, applicants did not rely upon JP 11-95712 when filing the US application and thus, applicants have not established constructive reduction to practice.

11. With respect to claims 16-19, it is noted that the evidence submitted in the 1.131 declaration, namely copy of JP 11-95712 and its English translation, is insufficient to establish conception and reduction to practice of the invention prior to the effective date of either Sakaki et al. or Gallucci et al. given that the 1.131 declaration is not commensurate in scope with the scope of claims 16-19. That is, present claims 16-17 disclose additional component added to the thermoplastic resin composition while claims 18-19 disclose additional component added to the molded article. However, there is no disclosure in the evidence or exhibit submitted in the 1.131 declaration of the conception and reduction to practice of thermoplastic resin composition or molded article that requires additional component as required in claims 16-17 or 18-19, respectively. There is no disclosure in JP 11-95712 of the additional ingredient required in present claims 16-19.

Response to Arguments

12. Applicants' arguments and declaration filed 5/27/04 have been fully considered but they are not persuasive.

Specifically, applicants argue that Sakaki et al. and Gallucci et al. cannot be used as references against the present claims in light of the 1.131 declaration filed 5/27/04 that establishes completion of the present invention of the present invention prior to the earliest US filing date of Gallucci et al.

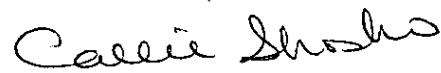
However, for the reasons set forth in paragraphs 10-11 above, the 1.131 declaration is ineffective in removing either Sakaki et al. or Gallucci et al. as references and thus, Sakaki et al. and Gallucci et al. remain as relevant references against the present claims.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
6/10/04